

Reconsideration of the rejection of claims 5-6 and 11-12 as being "in improper format" is requested. How or why is the expression "[p]roviding the single strap ankle brace of claims 1 [i.e., claims 5 and 6] and 7 [i.e., claims 11 and 12]" an "improper" format? Please cite and apply a relevant rule or precedent, or withdraw the rejection.

Claim Rejection under 35 U.S.C. §103(a)

(a) The Inventor's Statement

The inventor is Meldon L. Talbot, Ph.D. Dr. Talbot is an employee of Boulder Scientific Company, Mead, Colorado. Exhibit A is a copy of a document of record in parent application Serial No. 08/878,171. The document comprises:

- (1) A letter dated August 20, 1999 addressed to the Commissioner from the applicant regarding the parent application. The letter describes the making of the invention and the benefits from its use which have been personally observed by Dr. Talbot. It also comments on the Wise patent 3,777,751. It is important to understand that this letter was submitted to counsel solely on the inventor's own initiative. It was written entirely and exclusively by Dr. Talbot. No part of the letter was suggested or written by counsel.

- (2) A copy of a letter faxed by Dr. Talbot enclosing the inventor's aforementioned letter (1) above.
- (3) A copy of the August 23, 1999 "Further Response to Final Action Mailed June 7, 1999" filed and of record in parent application Serial No. 08/878,181. The "Further Response" transmitted and asked the examiner to consider the inventor's August 20, 1999 letter.

The Examiner is most respectfully requested to consider Dr. Talbot's August 20, 1999 letter in connection with the invention claimed in the current application which, as he points out, "is unique and gives unexpected benefits" (page 3). The letter also explains why, in Dr. Talbot's view, Wise patent 3,777,751 "may also help prevent an ankle from turning but it does so by a completely different mechanism" from the claimed invention (page 1).

(b) Response to Rejection

The §103(a) rejection states:

Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Castiglia ('746) in view of Wise ('751).

Castiglia discloses the invention substantially as claimed; however, Castiglia does not disclose a single strap of inelastic material. Wise teaches an ankle support comprising a single strap of inelastic material (col. 2,

lines 3-6). It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the inelastic strap taught by Wise onto the invention of Castiglia in order to allow the user to cover and apply pressure to the area as desired. (page 1)

1. The claims 1-12 do not stand or fall together. Claims 1 to 4 and 7 to 10 are for a "single strap ankle brace". Claims 5, 6, 11 and 12 are for a "method for bracing an ankle". The rejection does not assert that either of the cited references make the claimed methods "obvious".

Allowance of method claims 5, 6, 11 and 12 is requested.

2. The rejection is based on a combination of references "Castiglia ('746) in view of Wise ('751)". The criteria for determining the issue of "obviousness" under §103(a) are set forth in In re Dembiczak and Zinbarq, 59 USPQ2d 1614 (1999):

Our analysis begins in the text of section 103 quoted above, with the phrase "at the time the invention was made." For it is this phrase that guards against entry into the "tempting but forbidden zone of hindsight," see Loctite Corp. v. Ultraseal Ltd., 781 F.2d 861, 873, 228 USPQ 90, 98 (Fed.Cir. 1985), overruled on other grounds by Nebelpharma AB v. Implant Innovations, Inc., 141 F.3d 1059, 46 USPQ2d 1097 (Fed.Cir. 1998), when analyzing the patentability of claims pursuant to that section. Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. see, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed.Cir. 1983). Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one to "fall victim to the

insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." Id.

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.... [Citations omitted.]

We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed.Cir. 1996), Para-Ordinance Mfg. v. SGS Imports Intern., Inc., 73 F.3d 1085, 1088, 37 USPQ 1237, 1240 (Fed.Cir. 1995), although "the suggestion more often comes from the teachings of the pertinent references," Rouffet, 149 F.3d at 1355, 47 USPQ2d at 1456. The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g., C.R.Bard, 157 F.3d at 1352, 48 USPQ2d at 1232. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence". E.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed.Cir. 1993) ("Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact."); In re Sichert, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977) ("The examiner's conclusory statement that the specification does not teach the best mode of using the invention is unaccompanied by evidence or reasoning and is entirely inadequate to support the rejection."). In addition to demonstrating the propriety of an obviousness analysis, particular factual findings regarding the suggestion, teaching, or motivation to combine serve a number of important purposes, including: (1) clear explication of the position adopted by the Examiner and the Board; (2) identification of the factual disputes, if any, between the applicant and the Board; and (3) facilitation of review on appeal. Here, however, the Board did not make particular findings regarding the locus of the suggestion, teaching, or motivation to combine the prior art references.

Because we do not discern any finding by the Board that there was a suggestion, teaching, or motivation to combine the prior art references cited against the pending claims, the Board's conclusion of obviousness, as a matter of law, cannot stand. See C.R. Bard, 157 F.3d at 1352, 48 USPQ 2d at 1232; Rouffet, 149 F.3d at 1359, 47 USPQ2d at 1459; Fritch, 972 F.2d at 1265, 23 USPQ2d at 1783; Fine, 837 F.2d at 1075, 5 USPQ2d at 1600; Ashland Oil, 776 F.2d at 297, 227 UPSQ at 667. [Emphasis added.]

3. In this case, contrary to the requirements of Dembiczak, the examiner failed to make a "rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." Instead, the rejection is feebly supported only by the Examiner's undocumented, convenient but speculative conclusion that: "It would have been obvious to...substitute the inelastic strap taught by Wise onto the invention of Castiglia in order to allow the user to cover and apply pressure to the area as desired" (action, page 2). However, such "[b]road conclusory statements regarding the teaching of multiple references...are not 'evidence'", Dembiczak, supra., and do not justify a §103(a) rejection based on multiple references. Quite to the contrary, "particular findings regarding the locus of the suggestion, teaching, or motivation to combine the prior art references" must be made. Dembiczak, supra.

The rejection must be withdrawn, and the claims allowed because the Examiner did not make the required "particular

findings". Actually, the Examiner could not have done so because the written descriptions from Wise and Castiglia are inconsistent with the "substitution" premise of the rejection.

Among other things, the pending device claims 1 to 4 and 7 to 10 require "[a] single strap ankle brace" which must include all of the elements recited in the ensuing "wherein" limitations.

The rejection says that "Wise teaches an ankle support comprising a single strap of inelastic material (col. 2, lines 3-6)" (action, page 2). However, column 2, lines 3-6 of Wise must be read in context with the preceding paragraph, Col. 1, line 37 to Col. 2, line 2:

Referring now in detail to the drawings, there is shown in FIGS. 1 to 4 an ankle supporter 10 forming one embodiment of the invention including a tapered or flared, collar-like annular band 12 and a tongue or strap 14. The ankle supporter 10 is not banded. That is, it can be used for either the right foot or the left foot, and inside or outside, of the person using it, and is shown in FIGS. 2, 3 and 4 on the outside of a left foot 16 of the user. The user slips his foot through 16 through the band 12 of the ankle supporter, pulls the band down to the position thereof shown in FIGS. 2 and 4 with the tongue at the inner side of the foot and the band engaging the outer side of the ankle 17 and the upper portions of the foot and the heel. The tongue then is passed under the arch and cuboid portion 18 of the foot, is pulled taut upwardly and is adhesively taped by a tape 19 to the outer side of the lower portion 20, above the articulating point of the ankle, of the leg of the user. Taping of the tongue, while under tension, to the leg up above the ankle, in effect, attaches the cuboid portion 18, the underside of the foot, and the inner side of the foot, including the heel, to the leg above the ankle through an inelastic tendon, thereby permitting the foot to roll inwardly counter-clockwise, as viewed in FIG. 4, only slightly, and not sufficiently to sprain the ankle. Only a

few turns of the adhesive tape 19, around the portion 17 of the leg and under the foot, are needed to secure the tongue 14 to the portion 17 to prevent any inward roll sprain, only a small fraction of the adhesive tape previously required to tape an ankle. The taped supporter 10, other than limiting inward roll to a safe extent does not appreciably prevent all other flexing of the ankle.

Col. 2, lines 3-6 follow:

Each of the band 12 and strap 14 preferably is composed of a thin, strong, flexible, inelastic woven tape or webbing, one excellent webbing being of a cotton web with a herring bone weave and about 2 inches wide....

When correctly read in context, it is clear that the term said "strap 14" (Col. 2, line 3) refers to "tongue or strap 14" (Col. 1, line 40). But the Wise "tongue or strap 14" is not a "single strap ankle brace" as required by the pending device claims of this application. The Wise "tongue or strap 14" must be used in combination with the "collar-like annular band 12" (Col. 1, lines 37-42) and "[t]ap[ed]...under tension, to the leg up above the ankle" (Col. 1, lines 56-58). In Wise, there is no teaching of any use of the "tongue or strap 14" per se, i.e., in the absence of the "annular band 12" as a "single strap ankle brace" as claimed by Talbot. Indeed, the rejection concedes that point by the ambiguous assertion that "Wise teaches an ankle support comprising a single strap of inelastic material" (action page 2).

Furthermore, to substitute the "strap or tongue 14" of Wise somehow "onto the invention of Castiglia" as the rejection

speculates would require destruction of the Wise combined strap and band ankle support because the postulated substitution would require elimination of the Wise "collar-like annular band 12" which is a necessary element of the Wise invention. See also the Wise claims.

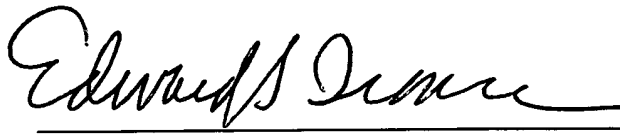
In sum, the rejection contends that it would have been "obvious" to select only the "strap 14" from the Wise ankle support combination of attached elements, remove the "strap 14", and then to provide that isolated inelastic strap 14 of Wise with the various elastic strap fastening tabs 16, 20, 21 and 23 of Castiglia, rearranged, however, to conform to the arrangement of hoops and loops required by applicant's claims, and in that way reasonably expect to achieve the claimed inventions.

This part of the rejection is also flawed. The flaw resides in the examiner's unsupported generality that "Castiglia discloses the invention substantially as claimed" (action, page 2). Actually, this generality is a cover up of the fact that the Examiner has not—apparently because the Examiner cannot—apply Castiglia to any of the claims and thus show that any of the "wherein" limitations of claims 1 to 4 and 7 to 10 are met or made obvious by Castiglia in combination with Wise.

Reconsideration and allowance of all claims now pending in this application are respectfully requested.

AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT

Any fee due in connection with the submission of this
"Response" should be charged to Deposit Account 09-0948.

A handwritten signature in cursive script, reading "Edward S. Irons", written over a horizontal line.

Edward S. Irons
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Dated: October 15, 2001

*FAX'ed to your
office 8/20/99*



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Edward S. Irons
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Dear Mr. Irons:

Please forward the enclosed letter to the appropriate patent official(s) at the U.S. Patent Office. Maybe it will clarify this situation.

Very truly yours,

Meldon L. Talbot
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(303) 530-4710



August 20, 1999

Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

RE: In re Application of Meldon L. Talbot, Serial No. 08/878,181, Filed June 18, 1997, For: "Ankle Brace", Art Unit 3764, Examiner: D. Pothier.

Sir:

The bottom line for my "Ankle Brace" is as follows. I am 60 years old. For 56 years of my life I suffered severe sprained ankle injuries 4-6 times a year. Each sprain resulted in ligament tears and severe swelling and bruising. My last sprained ankle in November, 1994, resulted in a fall which also broke my knee cap and required two surgeries. My ankles are currently painful and worn out. They will probable have to be surgically fused within a couple of years.

In desperation, I invented my "ankle brace" based on an inelastic, thin canvas ankle wrap I invented in the 1950's to wear during sporting activities. The 1950's ankle wrap had to be taped in place. It was effective in preventing sprains but it was not comfortable enough to wear all day, every day.

SINCE INVENTING THE NEW "ANKLE BRACE" I HAVE NOT HAD A SINGLE SPRAINED ANKLE IN THE LAST FOUR YEARS!!!!!!!!!!!!!! The figure 8 design and the use of an inelastic fabric are absolutely essential to the prevention of injury from ankle sprains. Two unexpected mechanisms became apparent after I had worn the "ankle braces" for a few months:

1. Each time I stepped on a rock on the sidewalk or any uneven surface my ankle would try to roll over, as usual, but was restrained by an immediate tug on the outside of my foot where the "ankle wrap" was located. This "tugging" action prevents most turned ankles.
2. About 5 or 6 times during this four year period I have stepped on the edge of a sidewalk or other sharp edged surface where it was impossible to not have my ankle roll over. In all of these cases my ankle did roll over forcefully, with all of my body weight on my twisting foot. Although this should have resulted in damage, swelling and bruising, in all cases the "ankle brace" completely prevented ankle dislocation and, therefore, there was absolutely no injury. This is the second and most unique unexpected result of the "ankle brace".

Both of these unexpected results are impossible to achieve with any ankle device that has any elastic part. The forces at work when an ankle decides to twist are too severe to be prevented by anything that is not rigid and strong.

The Wise patent, No. 3,777,751, may also help prevent an ankle from turning but it does so by a completely different mechanism. The "tongue" of Wise's device, as shown in figures 2,3 and 4, must be secured in place above the ankle by adhesive tape, wound tightly around the leg. See figure 2, number 19. Also see column 1, lines 50-55. Wise claims nothing about his device preventing ankle dislocation and injury in the case of the probable roll over of an ankle when one steps on the edge of any surface, like a sidewalk. In addition, the Wise device uses several wraps of adhesive tape on the lower leg and would not be comfortable enough to wear for extended periods.



One further advantage of my "ankle brace" is that it is effective when worn on the outside of my stockings. This prevents any irritation of the skin on my feet.

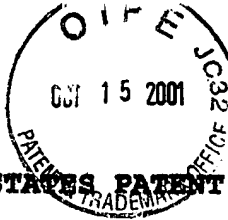
I invented my "ankle brace" too late to save my ankles. They were already worn out from years of ankle sprain injuries. However, my "ankle braces" have prevented significant pain for the last four years. I firmly believe that if I am able to market this invention it will eliminate injury from ankle sprains for anyone who will wear them. In particular, I believe my "ankle brace" will eliminate the need for "taping" the feet of athletes and will completely prevent ankle injuries in sporting events.

My "ankle brace" is unique and gives unexpected benefits. It should be patented. If the patent officials would like to have me demonstrate it's ease of wearing and mechanism of sprain prevention I would be happy to come to Washington, D.C., in person to make that presentation.

Respectfully,

Meldon L. Talbot

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

MELDON L. TALBOT

Serial No. 08/878,181

Filed: June 18, 1997

FOR: ANKLE BRACE

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: Art Unit 3764
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: Examiner: D. Pothier
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FURTHER RESPONSE TO FINAL ACTION MAILED JUNE 7, 1999

Honorable Commissioner of
Patents and Trademarks
Washington, D. C. 20231

Sir:

The examiner is respectfully requested to consider the attached communication to counsel from applicant in reaching a decision as to the allowability of the claims pending in the application.

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Dated: August 23, 1999

(via fax)